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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
COPPOLA, JACOB C

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jgardner@oblon.com

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/656,274
Filing Date: September 08, 2003
Appellant(s): KATO, YOSHIKAZU

Mr. Bradley D. Lytle and Mr. James Love
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 November 2009 appealing from the Office action

mailed 04 August 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: a new ground of rejection has been added.

NEW GROUND OF REJECTION

Necessitated by Appellant's arguments in the 2009 Appeal Brief, a new rejection under

35 U.S.C. §112, second paragraph is noted below under "NEW GROUNDS OF REJECTION."

The new ground of rejections is discussed last.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents (or PGPubs):

2002/0040374 A1	Kent	04 April 2002
2002/0065730 A1	Nii	30 May 2002

Non-Patent Literature:

White, "How Computers Work," Millennium Edition, 1999, Que Corporation,

Indianapolis, IN, chapter 14.

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC §101

35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 and 7-9 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1 and 7

Claims 1 and 7 recite computer programs *per se*. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because claims 1 and 7 recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention[1]. Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

Additionally, Applicant's original specification expressly states "[t]he series of steps described above may be executed by suitably functioning hardware or by software." Because of the "or" in "hardware <u>or</u> by software" (emphasis added), the specification supports an embodiment of the claimed invention to be software alone. See original specification, p. 31, last

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[1]35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures, and composition of matter. The latter three categories define "things" (or products) while the first category defines "actions" (*i.e.*, inventions that consist of a series of steps or acts to be performed).

line – p. 32, first line. Moreover, "A claim that covers both statutory and non-statutory

embodiments (under the broadest reasonable interpretation of the claim when read in light of the

specification and in view of one skilled in the art) embraces subject matter that is not eligible for

patent protection and therefore is directed to non-statutory subject matter." For additional

guidance, see USPTO Memorandum[2] by Acting Deputy Commissioner for Patent Examination

Policy Hirshfeld, Andrew H. titled Effective Today: New Interim Patent Subject Matter

Eligibility Examination Instructions, August 24, 2009[3]

Because the claimed "means" and "unit[s]" may be interpreted as software *per se*, the

claims are not within one of the four statutory classes of invention and are therefore rejected

under 35 U.S.C. §101.

Alternatively, the Examiner notes that using the broadest reasonable interpretation of

"unit," as provided in the Office action mailed on 18 March 2009 (p. 13, ¶ 27dd), the claimed

"unit[s]" are interpreted as software only. Because the broadest reasonable interpretation of

"unit" includes software *per se*, the claims are not within one of the four statutory classes of

invention and are therefore rejected under 35 U.S.C. §101.

Claims 2 and 3, which depend from claim 1, and claims 8 and 9, which depend from

claim 7, are rejected for the same reasons as above.

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[2] Available on the USPTO Internet at http://www.uspto.gov/patents/law/exam/memoranda.jsp

[3] See MPEP §707.06 "Citation of Decisions, Orders Memorandums, and Notices" expressly
authorizing the Examiner to cite to Commissioner's Memorandums which have not yet been
incorporated into the MPEP.

Claim Rejections - 35 USC §112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. §112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding Claims 1-3

The following claim elements are means-plus function limitations that invoke 35 U.S.C. §112, sixth paragraph (see analysis below):

The "ordering means for receiving at least one order corresponding to a genre" of claim 1;

The "managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre" of claim 1;

The "reading means for reading said plurality of content data from said storing means in response to an instruction" of claim 1;

The "arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means" of claim 1; and

The "composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display" of claim 1.

However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner has carefully searched the original specification and cannot determine the structure performing the recited functions.

The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112, second paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though the claims are indefinite, the claims are construed and the art is applied *as much as practically possible.*

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-5, 7, and 9, as understood by the Examiner, are rejected under 35 U.S.C.

§103(a) as being unpatentable over Kent (U.S. 2002/0040374 A1) ("Kent"), in view of Nii (U.S.

2002/0065730 A1) ("Nii").

Regarding Claims 1, 4, 5, and 7

Kent discloses the limitations:

ordering means (server **13**) for receiving at least one order corresponding to a

genre (¶¶ 0035 and 0048);

storing means (content database **160**) for storing a plurality of content data

corresponding to the at least one order (¶ 0079);

managing means (software program **100**) for managing preference data by which

to determine preferences based on previous orders (¶¶ 0062 and 0065-0068);

reading means (optimization program **48**) for reading said plurality of content

data from said storing means in response to an instruction (¶ 0079);

arranging means (profiling program **132**) for arranging said plurality of content

data read by said reading means, in accordance with said preference data managed by said

managing means (¶ 0079); and

composing means ("printer") for composing said plurality of content data

arranged by said arranging means, into a single document including the plurality of content data

for display (¶ 0083).

Kent also discloses orders corresponding to a genre (¶¶ 0048 and 0054).

Kent does not directly disclose a means "by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre," as recited in the claims.

Nii, however, discloses a method of and a system for distributing electronic content. In Nii's method, Nii teaches "a tailoring parameters register" by which to determine preferences ("tailorization parameters") based on a quantity of previous orders ("list of previous items purchased"), each order corresponding to a genre (¶¶ 0024, 0027, 0072, 0075, and 0079).

In Nii the preferences are used for "tailorization of the content to be delivered on a terminal per terminal basis," where "information to be delivered to that particular terminal is tailored in accordance with the preferences, settings, etc."

This ability of Nii demonstrates the ability of one of ordinary skill in the art to apply these teachings to similar systems, such as the system of Kent.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include the functionality of Nii's system (*i.e.*, determining preferences based on a quantity of previous orders, each order corresponding to a genre) in the managing means of Kent (*i.e.*, software program **100**) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claims 3 and 9

The combination of Kent and Nii discloses the limitations of claim 1, as shown above, and further discloses the limitations:

wherein said plurality of content data include at least information for distinguishing said

plurality of content data from other content data and information for indicating where said

plurality of content data are stored in said storing means (Kent, ¶¶ 0079 and 0099-0100).

Claims 2 and 8, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as

being unpatentable over the combination of Kent and Nii, in further view of Applicant's Own

Admission ("AOA") (see "Response to Arguments," OA mailed on 04 August 2009, ¶¶ 56 and

57).

<u>Regarding Claims 2 and 8</u>

The combination of Kent and Nii discloses the limitations of claim 1, as shown above,

and further discloses the limitations:

wherein said managing means determines said genre of said content data read by said

reading means (¶¶ 0065-0068: program **100** chooses relevant articles based on criteria, here the

type of article must be determined; see also ¶ 0061: program **48** ensures content matches user's

interests; ¶ 0078: prioritizing content based on user interests; and ¶¶ 0077 and 0079: program **48**

and program **132** choose content that best relates to user profile).

The combination of Kent and Nii does not directly disclose the managing means

associates the number of times that the plurality of content data belonging to said genre have

been read with information for identifying a user for management purposes.

However, Applicant admits that metering content usage on a per use basis and associating

the use with an identifier of a user is old and well-known in the art because this method reduces

the cost to a user who may only want to use the content once.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the managing means of Kent and Nii with the old and well-

known metering method. One would have been motivated to do so because this would provide a

convenience to the user and lower costs to access content.

New Ground Of Rejection

Claims 7 and 8 are alternatively rejected under 35 U.S.C. §112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention. In this alternative rejection, claim 7 is indefinite because it is

considered a hybrid claim and therefore rejected under 35 U.S.C. §112, second paragraph. See

MPEP §2173.05(p) II.

In the 2009 Appeal Brief at page 7 Appellants state:

> With regard to Claim 7, Applicants note that this claim is directed to an
> information processing apparatus which includes at least a management unit
> implemented using a central processing unit. Applicants note that this claim
> cannot be asserted as being software per se as the claim expressly recites that the
> management unit is implemented using a CPU. The outstanding Action asserts on
> page 14, in item 45, that "while a "central processing unit" may be interpreted as
> hardware, the central processing unit is not positively recited in the claim.
> Accordingly, the claim is interpreted as software per se. If the "using a central
> processing unit" was considered positively recited and because the term "using,"
> the claim would be indefinite under 35 U.S.C. § 112 2nd paragraph because the
> claim would be a hybrid claim. See MPEP §2173.05(p) II."
> In response, Applicants note that the central processing unit recited in
> Claim 7 is clearly positively recited. Asserting that this feature is not positively
> recited is unsupportable by the facts in question. Moreover, the assertion that the

claim would be a hybrid claim also is completely unsupportable. The phrase "a management unit implemented using a central processing unit" is not an attempt to claim a process without setting forth any steps as is discussed in MPEP 82173.05(D), such an assertion is not supportable by applicable law.

First, it is the Examiner's **principle** position that claim 7 is **not** a hybrid claim because the phrase "implemented using a central processing unit" only describes a *future* implementation of *how* the management unit is eventually implemented, *i.e.* it will eventually be implemented (but is not now implemented) by a central processing unit. In other words, the claim is interpreted to state that the "management unit [will be] implemented using a central processing unit . . . ." Because the phrase "*implemented* using [a CPU]" does *not* recite the present tense, the phrase is not positively recited. Under this principle position, because the phrase "implemented using a central processing unit" is not positively recited, the Board should *reverse* the 112, second paragraph Hybrid claim rejection but *maintain* the 35 U.S.C. §101 rejection.

Alternatively, if the Board finds that the phrase "implemented using a central processing unit" *is* recited in the present tense (and thus positively recites 'implementing using a [CPU]), the Board should **maintain** this (new) 35 U.S.C. § 112, second paragraph Hybrid claim rejection but reverse the 35 U.S.C. §101 rejection. Under this alternative interpretation, the claim requires "a management unit implement[ing] using a central processing unit."

Claim 7 is indefinite because it is considered a hybrid claim. See MPEP §2173.05(p) II. In particular, claim 7 is directed to neither a "process" or a "machine" but rather embraces or overlaps two different statutory classes of invention as set forth in 35 U.S.C. §101.

For example, claim 7 recites "[a]n information processing apparatus" and "a management unit...." Additionally, claim 8 recites "[a]n information processing apparatus according to claim 7...." In light of this evidence, one of ordinary skill in the art could reasonably interpret these

recitations as express intent by Applicant to claim a machine claim. Alternatively, claim 7 recites

"a management unit implemented *using* a central processing unit…" (emphasis added). One of

ordinary skill in the art could also reasonably interpret these recitations as express intent by

Applicant to claim a process claim. In light of this conflicting evidence, a person of ordinary skill

in the art could reasonably interpret claim 7 to be drawn to either a product or process.

Therefore in accordance with §2173.05(p) II which states that a single claim must be

drawn to either a product or process (but not both) and because a potential competitor of

Applicant would not know whether *possession alone* of the claimed structure constituted

infringement, or alternatively, if infringement required the *execution* of the recited method steps,

the claims are indefinite.

In *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 77 USPQ2d 1140 (Fed.

Cir. 2005), the Federal Circuit invalidated dependent claim 25 under 35 U.S.C. § 112, second

paragraph because it was considered a hybrid claim (*i.e.* it recited both a product claim (the

system) and a method for using that system). Claim 25 in *IPXL Holdings* read:

> *The system of claim 2* [including an input means] wherein the predicted
> transaction information comprises both a transaction type and transaction
> parameters associated with that transaction type, and *the user uses the input
> means* to either change the predicted transaction information or accept the
> displayed transaction type and transaction parameters. [Emphasis in original].

IPXL Holdings, 77 USPQ at 1145 (citations omitted).

To supports its position that the claim was indefinite, the court stated:

Thus, it is unclear whether infringement of claim 25 occurs when one *creates* a system that allows the user to change the predicted transaction information or accept the displayed transaction, *or* [alternatively] whether infringement occurs when the user *actually uses* the input means to change transaction information or uses the input means to accept a displayed transaction. Because claim 25 recites both a system and the method for using that system, it does not apprise a person of ordinary skill in the art of its scope, and it is invalid under section 112, paragraph 2. [Emphasis added].

IPXL Holdings, 77 USPQ at 1145 (citations omitted).

Applying *IPXL Holdings* to this application, it is unclear whether infringement of claim 7 occurs when one *creates* the information processing apparatus having the claimed structure, *or* alternatively, whether infringement occurs when the management unit *actual uses* the central processing unit.

In this application and as noted on page 7 of the 2009 Appeal Brief, Appellants were given *actual notice* that should they continue their arguments that the management unit is implemented with a CPU, a hybrid claim rejection would be set forth. Because Appellants have maintained their argument that the management unit is using a CPU, the Examiner has provided this new, alternative grounds of rejection under 35 U.S.C. § 112, second paragraph.

Claim Interpretation

35 U.S.C. 112, Sixth Paragraph

Means Phrase #1

Invocation

It is the Examiner's position that in claim 1, the phrase "ordering means for receiving at least one order corresponding to a genre" ("Means Phrase #1") is an attempt by Appellant to invoke 35 U.S.C. §112, sixth paragraph.

Invocation Step 1:

First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶* ("Guidelines")[4], and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d. 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),[5] Appellant's use of "means for" in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. §112, sixth paragraph. If the word "means" appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112, sixth paragraph applies. *Id.* Since "means for" is recited in Means Phrase #1, this step is clearly met.

Invocation Step 2:

Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner's position that Applicants recite a corresponding function to the means – "receiving at least one order corresponding to a genre."

The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by

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[4] Federal Register Vol. 65, No. 120, June 21, 2000.

[5] See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir.

2001). Here, the function as found in the Means Phrase #1 will have its ordinary meaning.

Invocation Step 3:

Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media*

Communications, LLC v. International Trade Commission, 161 F.3d 696, 704, 48 USPQ2d 1880,

1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure

for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which

perform the function. In determining whether the presumption of invocation is rebutted, "the

focus remains on whether the claim… recites sufficiently definite structure." *Id*. Furthermore,

sufficient structure does not require an exhaustive recitation – only structure to perform entirely

the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50

USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the "receiving at least one order corresponding to

a genre" can not be performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner's position that Means Phrase #1 invokes

35 U.S.C. 112, sixth paragraph.

The Examiner will next apply the above reasoning to all claimed phrases that potentially

invoke 35 U.S.C. §112, sixth paragraph. Citations and authorities will be omitted for clarity.

Means Phrase #2

It is the Examiner's position that the "storing means for storing a plurality of content data corresponding to the at least one order" ("Means Phrase #2") invokes 35 U.S.C. §112, sixth paragraph.

Means Phrase #2 meets **Invocation Step 1** because "means for" is recited.

Means Phrase #2 meets **Invocation Step 2** because the phrase recites the function of "storing a plurality of content data corresponding to the at least one order." This function will have its ordinary and plain meaning.

Means Phrase #2 meets **Invocation Step 3** because the claim does not recite sufficient definite structure for performing the function of "storing a plurality of content data corresponding to the at least one order."

Means Phrase #3

It is the Examiner's position that the "managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre" ("Means Phrase #3") invokes 35 U.S.C. §112, sixth paragraph.

Means Phrase #3 meets **Invocation Step 1** because "means for" is recited.

Means Phrase #3 meets **Invocation Step 2** because the phrase recites the function of "managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre." This function will have its ordinary and plain meaning.

Means Phrase #3 meets **Invocation Step 3** because the claim does not recite sufficient definite structure for performing the function of "managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre."

Means Phrase #4

It is the Examiner's position that the "reading means for reading said plurality of content data from said storing means in response to an instruction" ("Means Phrase #4") invokes 35 U.S.C. §112, sixth paragraph.

Means Phrase #4 meets **Invocation Step 1** because "means for" is recited.

Means Phrase #4 meets **Invocation Step 2** because the phrase recites the function of "reading said plurality of content data from said storing means in response to an instruction." This function will have its ordinary and plain meaning.

Means Phrase #4 meets **Invocation Step 3** because the claim does not recite sufficient definite structure for performing the function of "reading said plurality of content data from said storing means in response to an instruction."

Means Phrase #5

It is the Examiner's position that the "arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means" ("Means Phrase #5") invokes 35 U.S.C. §112, sixth paragraph.

Means Phrase #5 meets **Invocation Step 1** because "means for" is recited.

Means Phrase #5 meets **Invocation Step 2** because the phrase recites the function

of "arranging said plurality of content data read by said reading means, in accordance with said

preference data managed by said managing means." This function will have its ordinary and

plain meaning.

Means Phrase #5 meets **Invocation Step 3** because the claim does not recite

sufficient definite structure for performing the function of "arranging said plurality of content

data read by said reading means, in accordance with said preference data managed by said

managing means."

Means Phrase #6

It is the Examiner's position that the "composing means for composing said plurality of

content data arranged by said arranging means, into a single document including the plurality of

content data for display" ("Means Phrase #6") invokes 35 U.S.C. §112, sixth paragraph.

Means Phrase #6 meets **Invocation Step 1** because "means for" is recited.

Means Phrase #6 meets **Invocation Step 2** because the phrase recites the function

of "composing said plurality of content data arranged by said arranging means, into a single

document including the plurality of content data for display." This function will have its

ordinary and plain meaning.

Means Phrase #6 meets **Invocation Step 3** because the claim does not recite

sufficient definite structure for performing the function of "composing said plurality of content

data arranged by said arranging means, into a single document including the plurality of content

data for display."

Conclusion

The specification fails to directly disclose what structural elements make up Means

Phrases #1-6. In other words, the corresponding structure is not clearly linked in the written

description with the required specificity.

Additional Examiner Findings of Fact and Conclusions of Law

Additional Examiner Findings of Fact (EFF)

The Examiner finds that Appellant's petition under 37 C.F.R. §1.181 filed on 30 October

2009, requesting the withdrawal of the objection to the specification set forth in the final

rejection mailed on 04 August 2009, has been denied. See Decision on Petition to Withdraw

Objections to the Specification under 37 C.F.R. §1.181 mailed on 14 January 2010.

The Examiner finds that the original specification does <u>not</u> provide any lexicographic

definitions (either express or implied) of the terms or phrases found in the claims now on appeal.

Appellant expressly states in their 09 May Response, "Specifically, Claim 1 recites

means-plus-function features which must be considered in view of 35 U.S.C. §112, sixth

paragraph." See 09 May Response, p. 7.

The Examiner finds that Appellant states on page 2 in Section V. of the 2009 Brief in the

"Summary of Claimed Subject Matter" section that the "ordering means for receiving at least one

order corresponding to the genre" as recited in claim 1 is item **101**. The Examiner finds that the

original specification describes item **101** on page 12 as "order accepting part **101**...."

The Examiner finds that Appellant states on page 2 in Section V. of the 2009 Brief in the "Summary of Claimed Subject Matter" section that the "storing means for storing a plurality of content data corresponding to the at least one order" as recited in claim 1 is items **58** and **112**. The Examiner finds that the original specification describes items **58** and **112** on page 13 as "storage unit **58**…" and "content data **112**," respectively.

The Examiner finds that Appellant states on pages 2 and 3 in Section V. of the 2009 Brief in the "Summary of Claimed Subject Matter" section that the claimed "managing means for managing preference data by which to determine preferences based on a quantity of previous orders, each order corresponding to a genre" as recited in claim 1 is item **102**. The Examiner finds that the original specification describes item **102** on page 13 as "the preference determining part **102**…."

The Examiner finds that Appellant states on page 3 in Section V. of the 2009 Brief in the "Summary of Claimed Subject Matter" section that the claimed "reading means for reading said plurality of content data from said storing means in response in response to an instruction" as recited in claim 1 is item **103**. The Examiner finds that the original specification describes item **103** on page 13 as "the selecting part **103**…."

The Examiner finds that Appellant states on page 3 in Section V. of the 2009 Brief in the "Summary of Claimed Subject Matter" section that the claimed "arranging means for arranging said plurality of content data read by said reading means, in accordance with said preference data managed by said managing means" as recited in claim 1 is item **104**. The Examiner finds that the original specification describes item **104** on page 13 as "the sorting part **104**."

The Examiner finds that Appellant states on page 3 in Section V. of the 2009 Brief in the "Summary of Claimed Subject Matter" section that the claimed "composing means for composing said plurality of content data arranged by said arranging means, into a single document including the plurality of content data for display" as recited in claim 1 is item **105**. The Examiner finds that the original specification describes item **105** on page 13 as "[t]he composing part **105** ...."

The Examiner finds that other sections of the original specification do <u>not</u> further describe or shed light on what specifically constitutes the order accepting part **101**, the storage unit **58** and content **112**, the preference determining part **102**, the selection part **103**, the sorting part **104**, nor the composing part **105**. In particular, the Examiner finds that the original specification does *not* describe—let alone even indicate—a particular algorithm that performs the various phrases that invoke 35 U.S.C. §112, sixth paragraph.

The Examiner finds that the section titled "VII. Argument" in the 2009 Appeal Brief does <u>not</u> provide any additional guidance as to what constitutes the corresponding structure for the phrases that invoke 35 U.S.C. § 112, sixth paragraph. In particular, the Examiner finds that the Argument section of the 2009 Appeal Brief also does set forth a particular algorithm that performs the various phrases that invoke 35 U.S.C. §112, sixth paragraph.

The Examiner finds that claims 4, 5, and 7-9 recite neither "step for" nor "means for."

Additional Examiner Conclusions of Law

Because claims 4, 5, and 7-9 recite neither "step for" nor "means for," claims 4, 5, and 7-9 fail Prong (A) as set forth in MPEP §2181 I. Because claims 4, 5, and 7-9 fail Prong (A) as set forth in MPEP §2181 I., the Examiner adopts the presumption (and concludes) that claims 4, 5,

and 7-9 do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d

1207, 1215-16 (B.P.A.I. 2008)(precedential)(where the Board concluded that because the

phrases at issue did not use "means for" and because appellants had the opportunity to amend the

claims to recite "means for" if appellants desired 35 U.S.C. §112, 6th paragraph to be invoked,

the claimed phrases at issue did not invoke 35 U.S.C. §112, 6th paragraph.).

(10) Response to Arguments

35 U.S.C. §101 Arguments

Overview

It is the Examiner's principle position that Claims 1-3 and 7-9 are rejected under 35

U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Specifically, claims 1 and 7 recite computer programs *per se*. "Computer programs

claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not

physical 'things.' They are neither computer components nor statutory processes, as they are not

'acts' being performed." MPEP §2106.01 I.

Additionally, Appellant's original specification expressly states "[t]he series of steps

described above may be executed by suitably functioning hardware or by software."

Specification, p. 31, last line – p. 32, first line. Because the claimed "means" (of claim 1) and

"unit[s]" (of claim 7) may be interpreted as software *per se*, the claims are not within one of the

four statutory classes of invention.

Alternatively, the Examiner notes that using the broadest reasonable interpretation of

"unit," as provided in the Office action mailed on 18 March 2009 (p. 13, ¶ 27dd), the claimed

"unit[s]" (of claim 7) are interpreted as software only. Because the broadest reasonable

interpretation of "unit" includes software *per se*, the claims are not within one of the four

statutory classes of invention and are therefore rejected under 35 U.S.C. §101.

Additionally, with respect to claim 1, the Examiner has concluded that the corresponding

structure of the means plus function elements cannot be determined (see 35 U.S.C. §112, second

paragraph rejection above; see also detailed 35 U.S.C. §112, sixth paragraph invocation analysis

above; and see also detailed arguments below).

Appellant's Arguments

With respect to claim 1, Appellant argues:

> In the present case, as is noted above in section V, the structure of the means plus
> function elements of Claim 1 is clearly found in the disclosure as originally filed.
> Moreover, Applicants note that Figure 3 clearly illustrates the structure of the
> information processing apparatus recited in Claim 1. Moreover, page 10, line 23,
> to page 11, line 1 clearly states that the CPU 51 utilizes program code stored in
> RAM 53 to perform its processes. In other words, the CPU 51 is configured by
> the program code stored in the RAM 53 to perform certain processes. In support
> of this position, Applicants note *WMS Gaming, Inc. v. International Game
> Technology*, 184 F.3d 1339 (Fed. Cir. 1999), where the Federal Circuit held that
> the time domain processing means is a microprocessor programmed to carry out
> the algorithm. In WMS Gamming, the Federal Circuit noted the statutory
> requirement to focus on corresponding structure.

See 2009 Appeal Brief, P6 L4-14 (emphasis in original).

First, Appellant contradicts his own findings of "section V" by stating "Figure 3 clearly

illustrates the structure of the information processing apparatus recited in Claim 1." As

discussed above, The Examiner has found that the means plus function elements of Claim 1, <u>as</u>

<u>described by Appellant in Section V. of the 2009 Brief</u> in the "Summary of Claimed Subject

Matter" section, are the order accepting part **101**, the storage unit **58** and content **112**, the

preference determining part **102**, the selection part **103**, the sorting part **104**, and the composing

part **105** (see EFF above). The total of these elements are described in Figure 4, *not* Figure 3. In

fact, *only* the storage unit **58** is found in both Figures 3 and 4.

Second, it appears that Appellant believes claim 1 is statutory (with respect to §101)

based on the "CPU 51" and "RAM 53" as described on pp. 10-11 of the original specification,

even though the "CPU 51" and "RAM 53" are *not* what Appellant points to in "section V" as the

corresponding structure of the claim elements. Therefore, going on Appellants own summary of

claimed subject matter, the "CPU 51" and "RAM 53" are not elements of claim 1. Accordingly,

claim 1 cannot be determined statutory under §101 based on these elements.

Third, Appellant's reliance on *WMS Gaming, Inc. v. International Game Technology*,

"where the Federal Circuit held that the time domain processing means is a microprocessor

programmed to carry out *the algorithm*" (emphasis added), should not be persuasive. As noted

above (see EFF), the original specification does not describe—let alone even indicate—a

particular algorithm that performs the various phrases that invoke 35 U.S.C. §112, sixth

paragraph. Accordingly, the facts of this case are distinguishable from the facts of *WMS

Gaming*.

With respect to claim 1, Appellant argues:

> The outstanding Action states that "Applicant's original specification express
> states "[t]he series of steps described above may be executed by suitably
> functioning hardware or by software." However, the outstanding Action has taken
> this phrase out of context. Specifically, the next line of the disclosure states "[f]or

> software-based processing to take place, programs constituting the processing
> sequences may be either loaded from dedicated hardware of a computer into its
> internal memory for execution, or installed upon program execution form a
> suitable program storage medium into a general-purpose personal computer or
> like equipment capable of executing diverse functions." Thus, the specification
> clearly does not indicate that the invention can be performed using software only.

See 2009 Appeal Brief, P6 L15-23.

The Examiner disagrees with Appellant's assertion that "the next line of the disclosure"

shows that the lines of the disclosure relied upon by the Examiner are taken out of context. In

fact, it is exactly "the next line of the disclosure" that shows *why* claim 1 is *not* statutory. Claim

1 only recites elements that are equivalent to the "programs constituting the processing

sequences" (*i.e.*, the order accepting part **101**, the storage unit **58** and content **112**, the preference

determining part **102**, the selection part **103**, the sorting part **104**, and the composing part **105**).

Claim 1 *does not* recite an element that is equivalent to the "dedicated hardware… for execution"

of the programs, nor does claim 1 recite an element that is equivalent to "a general purpose

computer" for which the programs are installed and executed.

At best, Appellant's argument shows that claim 1 is even further *indefinite* for omitting

essential structural elements, namely the "dedicated hardware… for execution" of the programs

(or "a general purpose computer" for which the programs are installed and executed). See MPEP

§2172.01.

With respect to claim 7, Appellants argue:

> With regard to Claim 7, Applicants note that this claim is directed to an
> information processing apparatus which includes at least a management unit
> implemented using a central processing unit.

See 2009 Appeal Brief, P7 L7-9.

As an initial matter, and with particular attention to "this claim is directed to an information processing apparatus," the Examiner notes that the recitation of "[a]n information processing apparatus" is *only* in the *preamble* of claims 1 and 7. The preamble of claim 7 (and claim 1, for which this same argument applies) is *not* construed as a limitation because it is not necessary to give life, meaning, and vitality to the claim. See *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002).

Additionally, it is the Examiner's principle position the central processing unit relied upon by Appellant is interpreted to be outside the scope of claim 7. It is therefore the Examiner's principle position that Claim 7 does not require a central processing unit ("CPU") as a component. Rather, it merely requires a "management unit" that is *implemented* using a CPU. The Examiner concedes that each of the units (when interpreted as software *per se*) requires some hardware for *implementation* (*e.g.*, a CPU for executing the software units, a mouse, a display, a keyboard, etc.), but that is not to say that each unit then *must* be partly hardware, nor is that a reason to assume that the scope of the claim is anything other than software *per se*. Accordingly, because the claim recites "a management unit *implemented* using a processing unit," the claimed management unit can be interpreted as a required component, which in turn uses a CPU for implementation purposes (the CPU being outside the scope of the claimed elements; *i.e.*, the CPU is not required for anticipation and/or infringement).

35 U.S.C. §112, Second Paragraph Arguments, in view of 35 U.S.C. §112, Sixth Paragraph

Overview

It is the Examiner's principle position that claims 1-3 are indefinite under 35 U.S.C. §112, second paragraph because the claim phrases that invoke 35 U.S.C. §112, sixth paragraph, fail to clearly link and associate the claimed functions to the corresponding structure in the specification.

Based upon a review of Appellant's original specification, claims, and drawings, Appellant's 09 May Remarks, and Appellants arguments as set forth in the 2009 Appeal Brief, the Examiner is unable to ascertain the corresponding structure for means plus function phrases.

Appellant's Inconsistent Arguments as to What Is the Corresponding Structure

Additionally, the Examiner notes that based upon a review of the prosecution history, Appellant has made inconsistent arguments as to what is (and what is not) the corresponding structure of the means plus function elements.

For example, Appellant has made inconsistent arguments as to what constitutes the corresponding structure for the "storing means for storing a plurality of content data corresponding to the at least one order" as recited in claim 1. In particular, the prosecution history indicates that Appellant has argued at least 3 mutually exclusive interpretations as to what is the corresponding structure.

Initially and in response to the First Non Final Office Action, Appellant, in his 09 May Remarks, states that the corresponding structure includes central processing unit ("CPU") **11**:

> A person of ordinary skill in the art would recognize, based on the present specification, that an example of the "means" described in the

specification includes the central processing unit 11 of device 2 shown in Applicants' Fig. 2, and the algorithm executed by the processor. Thus, the claimed "means" is not software per se, but includes the central processing unit and the algorithm.

See 09 May Remarks, P7 L20 to P8, L4.

However later on in the 09 May Remarks, Appellant revises his position on the corresponding structure for the "storing means for storing" and argues that the corresponding structure is only "a hard disk":

> For example, with regard to the storing means for storing a plurality of content data corresponding to the at least one order, Applicants respectfully submit that the storage means clearly corresponds to the "storage unit" shown in Figures 2-4 and described on page 11 as formed by a hard disk or the like.

See 09 May Remarks, Pg 8.

Finally and on appeal, Appellant revises the corresponding structure *yet again* and for the first time now states in his "Summary of Claimed Subject Matter" ("SCSM") on page 2 of the 2009 Appeal Brief that the corresponding structure is not only "storage unit" **58**, but also the content data **112**. See footnote 3 in the 2009 Appeal Brief where Appellants expressly state that the corresponding structure for the "storing means for storing" as "Figure 4, items 58 and 112 and page 13, lines 6-9." The SCSM makes no mention of CPU **11** or any algorithm as originally argued in the 09 May Remarks.

Therefore according to Appellant's arguments alone, the corresponding structure for the "storing means for storing" could be any one of: (1) CPU **11** and "the algorithm"; (2) "storage unit" **58**; or (3) "storage unit" **58** in combination with "content data" **112**.

Appellant is reminded that "[j]ust as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the

PTO may bar an inconsistent position on claim construction under §112, ¶ 6." *Ballard*

Medical Products v. Allegiance Healthcare Corp., 268 F.3d 1352, 1359, 60 USPQ2d

1493, 1499 (Fed. Cir. 2001) (citations omitted).

Because the original specification itself does not state what is the particular

corresponding structure for the "storing means for storing," because Appellants have

offered up at least three (3) mutually exclusive positions as to what constitutes the

corresponding structure for the "storing means for storing," and because positions taken

before the PTO may bar an inconsistent position on claim construction under §112, ¶ 6,

claim 1 must be considered indefinite.

In order to address other arguments in this appeal and because the 2009 Appeal

Brief is Appellants latest submission, the Examiner will presume that the SCSM as stated

in the 2009 Appeal Brief sets forth Appellants best arguments as to what constitutes the

corresponding structure of the means plus function phrases.

The Specification Does Not Clearly Link and Associate Corresponding Structure to the Claimed Functions

In particular, the Examiner will show that in claim 1 of the instant application, Appellant

has attempted to capture any possible means for achieving the claimed functions by using purely

functional claiming.

Claim 1 recites 6 phrases that invoke 35 U.S.C. §112, 6th paragraph. For example, claim

1 recites "reading means for reading said plurality of content data from said storing means in

response in response to an instruction" ("Means Phrase #4" or "MP #4"). While the following

analysis applies to all phrases that invoke 35 U.S.C. §112 6th paragraph, the Examiner will address

MP #4 in depth.

Claimed Function

Based upon the claim language itself, the Examiner concludes that the function of

MP #4 is "reading said plurality of content data from said storing means in response in response to

an instruction."

Additionally, "[u]nless something in the written description suggests that the

patentee intended the unambiguous language to be construed in a manner inconsistent with its

ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom*

Inc., 246 F.3d 1316, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Because the written description

does not suggest otherwise, MF#2 will have its ordinary meaning.

Corresponding Structure

"The next step is to determine the corresponding structure described in the

specification and equivalents thereof. Structure disclosed in the specification is 'corresponding'

structure only if the specification or prosecution history clearly links or associates that structure

to the function recited in the claim." *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.*

248 F.3d 1303, 1311, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001) (citations omitted).

"It is well settled that 'if one employs means-plus-function language in a claim,

one must set forth in the specification an adequate disclosure showing what is meant by that

language.'" *Blackboard Inc. v. Desire2Learn Inc.*, 91 USPQ2d 1481, 1490 (Fed. Cir. 2009)

quoting *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (en banc).

"The duty of a patentee to clearly link or associate structure with the claimed function is the quid pro quo for allowing the patentee to express the claim in terms of function under section 112, paragraph 6. Section 112, paragraph 6 was intended to allow the use of means expressions in patent claims without requiring the patentee to recite in the claims all possible structures that could be used as means in the claimed apparatus. However, the price that must be paid for use of that convenience is limitation of the claim to the means specified in the written description and equivalents thereof. If the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid that price but is rather attempting to claim in functional terms unbounded by any reference to structure in the specification. Such is impermissible under the statute." *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003)(citations and quotations omitted).

Corresponding Structure in a Computer Implemented Invention

"A general purpose computer, or microprocessor, programmed to carry out an algorithm creates 'a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.'" *WMS Gaming Inc. v. International Game Technology*, 184 F3d 1339, 1348, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999) citing *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed.Cir. 1994) (en banc).

In other words, "a computer-implemented means-plus-function claim is limited to a computer programmed to perform the algorithm disclosed in the specification." *Creo Products Inc. v. Presstek Inc.*, 305 F.3d. 1337, 1345, 64 USPQ2d 1385, 1389 (Fed. Cir. 2002) citing *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1348, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999). In other words, in computer implemented inventions, the corresponding structure is a general purpose computer programmed to carry out an algorithm.

"In cases involving a computer-implemented invention in which the inventor has invoked means-plus-function claiming, this court has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor. The point of the requirement that the patentee disclose particular structure in the specification and that the scope of the patent claims be limited to that structure and its equivalents is to avoid pure functional claiming. . . . For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to 'the corresponding structure, material, or acts" that perform the function, as required by section 112 paragraph 6.'" *Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, 521 F.3d 1328, 86 USPQ2d 1235, 1239 (Fed. Cir. 2008)(citations and quotations omitted).

"Consequently, a means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an

algorithm for performing the claimed function." *Net MoneyIN v. Verisign*, 88 USPQ2d 1751,

1757 (Fed. Cir. 2008).

Blackboard Inc. v. Desire2Learn Inc.

It is the Examiner's position that this instant application is similar to the facts as

recited in *Blackboard Inc. v. Desire2Learn Inc.*, 91 USPQ2d 1481 (Fed. Cir. 2009).

In Blackboard, the Federal Circuit upheld the district court's determination that

claim 1 was indefinite under 35 U.S.C. §112, second paragraph because the "patent discloses

insufficient structure to perform the function of 'assigning a level of access to and control of

each data file based on a user of the system's predetermined role in a course.'" Blackboard at

1493.

Before the district court, Blackboard asserted that the structure that performs the

recited "means for assigning" function is "a server computer with an access control manager

[ACM] and equivalents thereof." Blackboard at 1490. The Federal Circuit reviewed the

specification and noted that the ACM was simply an abstraction that described the claimed

function. *How* the ACM performs the claimed function was not disclosed. "The ACM is

essentially a black box that performs a recited function. But how it does so is left undisclosed."

Id.

The Federal Circuit next went on to discuss or mention *Aristocrat Technologies*

Australia Pty Ltd. v. International Game Technology, 521 F.3d 1328, 1331,86 USPQ2d 1235

(Fed. Cir. 2008); and *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 88 USPQ2d 1751 (Fed.

Cir. 2008). The court also mentioned *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 86

USPQ2d 1609 (Fed. Cir. 2008).

For example, the court in Blackboard noted in that in Net MoneyIn, "[b]ecause

there was no disclosed algorithm in that case, we held that the claims were invalid for lack of a

sufficient recitation of structure." Blackboard at 1492. The court in Blackboard also quoted

Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340-41 [86 USPQ2d 1609] (Fed. Cir.

2008) ("Simply reciting 'software' without providing some detail about the means to accomplish

the function is not enough.").

Applying Blackboard to the Instant Application

As noted above, Appellants state on page 3 in Section V. of the 2009 Brief in the

"Summary of Claimed Subject Matter" section that the claimed "reading means for reading said

plurality of content data from said storing means in response in response to an instruction" as

recited in claim 1 is item **103**. The original specification describes item **103** on page 13 as "the

selecting part **103**...."

Like Blackboard, "selecting part **103**" in the instant application does not in any

way show *how* the function in MP #4 is performed. As noted in Figure 4 of Appellants'

drawings, "Selecting Part" **103** is literally a box. Like *Blackboard*, Appellants' specification is

completely silent as to how the claimed function is performed. While the box in Appellants

description is not 'a *black* box' is stated in *Blackboard*, "Selecting Part" **103** is nevertheless just

a box.

Additionally, the 2009 Appeal Brief fails to set forth a single algorithm that

performs the function as set forth in MP #4, let alone point to an algorithm in the original

specification that performs that function.

Finally, the Federal Circuit concluded its analysis in Blackboard and noted that:

> By failing to describe the means by which the access control
> manager will create an access control list, Blackboard has
> attempted to capture any possible means for achieving that end.
> Section 112, paragraph 6, is intended to prevent such pure
> functional claiming.

Blackboard at 1493.

Applying this reasoning to the instant application, the Examiner concludes

that by failing to describe the means by which selecting part **103** will read said plurality

of content data from said storing means in response to an instruction, Appellant has

attempted to capture any possible means for achieving that end. As noted in Blackboard,

section 112, paragraph 6, however is intended to prevent such pure functional claiming.

If Appellant files a Reply Brief in this application and to assist the

Board in this appeal, Appellant is <u>strongly encouraged</u> to discuss why the reasoning

in Blackboard, Aristocrat, and Net MoneyIN does or does not apply to the instant

application.

Appellants Corresponding Structure Does Not Perform the Claimed Function

The Examiner finds that claim 1 recites "storing means for storing a plurality of content

data corresponding to the at least one order…." (hereinafter "MF#2"). Based upon the claim

language itself, the Examiner concludes that the function of MF#2 is "storing a plurality of content data corresponding to the at least one order."

Additionally and as noted above, "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 246 F.3d 1316, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Because the written description does not suggest otherwise, MF#2 will have its ordinary meaning.

The next step is determining the corresponding structure. "It is well settled that 'if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language.'" *Blackboard Inc. v. Desire2Learn Inc.*, 91 USPQ2d 1481, 1490 (Fed. Cir. 2009) quoting *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (en banc).

Appellant argues that the corresponding structure of MF#2 is "storage unit" **58** in combination with content data **112**. See footnote 3 on pg 2 in the 2009 Appeal Brief where Appellant expressly states that the corresponding structure for the "storing means for storing" as "Figure 4, items 58 and 112 and page 13, lines 6-9."

Appellant's assertion however is technologically not possible since one of ordinary skill in the art recognizes that data can not perform the recited "storing" function. See White, chapter 14, pp. 140-151. Therefore because content data **112** <u>can not</u> perform the function of "storing a plurality of content data corresponding to the at least one order," it can not be corresponding structure. In other words, because content data **112** is actually the content data <u>that is being stored</u>, it can not be part of the structure that does the storing. See *Northrop Grumman Corp. v.*

Intel Corp., 325 F.3d 1346, 1352-43, 66 USPQ2d 1341, 1345 (Fed. Cir. 2003) ("The signals that are monitored by the 'means for monitoring' cannot be part of the structure that does the monitoring.") citing *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581, 42 USPQ2d 1777, 1780 (Fed. Cir. 1997) (the passage through which a slug travels "is not the means that causes the passing").

The Examiner concludes that Appellant's assertion in the 2009 Appeal Brief that the corresponding structure for the "storing means for storing a plurality of content data corresponding to the at least one order" is "storage unit" **58** in combination with content data **112** is technologically impossible because data **112** can not perform the claimed function. Because data **112** can not performed the claimed function, the claim is indefinite under 35 U.S.C. § 112 2nd paragraph.

35 U.S.C. §112, Second Paragraph Arguments - Hybrid Claims

The new grounds of rejection under §112 is a **secondary** position against claims 7 and 8. To be especially clear, it is the Examiner's principle position that the claimed "central processing unit" is *not* positively recited, and therefore the claimed "central processing unit" does not cure the deficiencies of claim 7 with respect to §101. See §101 arguments above.

Nevertheless, Appellant now argues "the ***central processing unit recited in Claim 7 is clearly positively recited*.**" See 2009 Appeal Brief, p. 7, l. 17-18. Even though the Examiner disagrees with Appellant's assertion, if Appellants' arguments were meritorious, claim 7 would then be indefinite because it's a hybrid claim since the claimed "management unit" would be "***using*** a central processing unit." See MPEP §2173.05(p) II., *IPXL v. Amazon*, 430 F3d 1377,

77 USPQ 2d 1140 (Fed. Cir. 2005), and the discussion under the New Grounds of Rejection

above.

Prior Art Arguments

Overview

It is the Examiner's principle position that claims 1, 3-5, 7, and 9, as understood by the

Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Kent, in view of Nii.

Appellant Groups Independent Claims 1, 4, 5, and 7

Appellant's arguments against the rejection under §103 are presented on pp. 9-11 of the

2009 Appeal Brief. Appellant addresses the alleged patentable features of claim 1 in detail and

does not address any alleged patentable features of independent claims 4, 5, and 7 in separate

arguments. Rather Appellant argues that claims 4, 5, and 7 are patentable for reasons *similar* to

the reasons for claim 1 (see 2009 Appeal Brief, p. 11, l. 15-16).

Because claims 4, 5, and 7 are not argued separately, claims 4, 5, and 7 will stand or fall

with the patentability of claim 1.

Because Appellant only argues claim 1, and because Appellant does not present separate

arguments for claims 4, 5, and 7, the Examiner will only address claim 1 for prior art purposes.

Claim 1 – Primary Position for Rejection under §103

As an initial matter, the Examiner has determined that Appellant attempts to claim a

machine in claim 1. See *e.g.*, section VII. A. of the 2009 Appeal Brief, in which Appellant

attempts to show that claim 1 is directed to a machine. Moreover, and as discussed above, claim

1 recites six means-plus-function elements that have been interpreted under 35 U.S.C. §112, sixth paragraph.

It is well known for a machine claim, if a limitation of the claim invokes 35 U.S.C. §112, sixth paragraph, it must be interpreted to cover the corresponding *structure* in the specification and "equivalents thereof." See 35 U.S.C. §112, sixth paragraph. See also *B. Braun Medical, Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997).

Because claim 1 is an attempt to claim a machine, and because the elements of claim 1 invoke §112, sixth paragraph, claim 1 must be interpreted to cover the corresponding structure in the specification and "equivalents thereof."

In the rejection above, the Examiner has interpreted claim 1 to cover the corresponding structure in the specification and "equivalents thereof." However, as discussed above, the corresponding structure cannot be determined, and therefore an accurate comparison of the claimed invention to the prior art is impossible at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). On this basis alone, claim 1 is not distinguishable over the prior art. This is the Examiner's primary position and the rejection under §103 should be sustained on this basis alone.

Claim 1 – Alternative Position for Rejection under §103

Despite the Examiner's primary position, as outlined above, and as mirrored in the Examiner's numerous Office actions prior to the 2009 Appeal Brief, the Examiner has applied the prior art to claim 1 despite its deficiencies. This is an alternative position, but in accordance

with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art

rejections even though a claim is indefinite, the Examiner has construed the claims and has

applied the prior art as much as practically possible. To do this, the Examiner searched the prior

art for the functions claimed in claim 1 and applied the *structure* of the prior art performing these

functions as an equivalent to the *structure* missing in Appellant's specification.

In Appellant's 2009 Appeal Brief, Appellant is now arguing that the prior art does not

disclose the *functions* of claim 1 in an attempt to show that the prior art does not disclose the

corresponding *structure*, which of course cannot even be determined at this time. As a matter of

law, the *functions* cannot distinguish claim 1 over the prior art, instead it is the *structure*

corresponding to the functions that is weighed for patentability. Regardless, in the case where

the Board disagrees with this analysis, the Examiner will address the Appellant's arguments for

the *function* and show where the functions are disclosed in the prior art.

With respect to claim 1, Appellant argues:

> However, the combination of <u>Kent</u> and <u>Nii</u> does not describe or suggest
> managing, using the information processing apparatus, preference data by which
> to determine preferences based on a quantity of previous orders, each order
> corresponding to a genre and arranging, using the information processing
> apparatus, said plurality of content data read in said reading, in accordance with
> said preference data managed in said managing, as is recited in Claim 1.

See 2009 Appeal Brief, P10 L3-8 (emphasis in original).

The Examiner respectfully disagrees. First, Appellants do not dispute the *combination* of

Kent and Nii.

Second, and as cited in the rejection above, Kent's "automatic personalization software

program **100**," as described by Kent in at least ¶¶ 0055, 0062, and 0065-0068, clearly performs

managing preference data ("data for the automatic profiling function of the present invention")

by which to determine preferences based on previous orders (*e.g.*, "downloaded files" and "credit card purchase"), each order corresponding to a genre (at least downloaded files would *inherently* have a corresponding genre (*i.e.*, "a type or class"), as provided in the Office action mailed on 18 March 2009). Therefore, the corresponding *structure* in the prior art that performs the "managing…" is the "automatic personalization software program **100**."

Third, Kent's "profiling program **132**," as described by Kent in at least ¶¶ 0077-0079, clearly performs arranging said plurality of content data read in said reading, in accordance with said preference data managed in said managing. First, the "optimization program **48**" performs the reading (¶ 0079, "a database of content **160**… is created and accessed by the optimization program **48**"), then after the database is read by the "optimization program **48**," Kent goes on to describe the selection of the content by the "profiling program **132**" ("the profiling program **132**… to select the most relevant content in the content database **160** for the particular subscriber, based on the 'profile' of the subscriber…"). In view of Kent's description of content selection based on user parameters in ¶ 0078, the Examiner interprets Kent's selecting of content to be analogous to the claimed "arranging" (see Kent, at least ¶ 0078, "[t]he values... determine the resulting *prioritization* of the content" (emphasis added)). Clearly, the performance of the reading and selecting by the "optimization program **48**" and "profiling program **132**" results in a prioritized arrangement (*i.e.*, "arranging") of content based on the user's profile. Accordingly, the corresponding *structure* in the prior art that performs the "reading…" and "arranging…" is the "optimization program **48**" and "profiling program **132**."

Finally, the only difference between the claimed invention and Kent is that Kent's

software program **100** does not determine preferences based specifically on a *quantity* of

previous orders.

Nii, in a related endeavor, discloses a method of and a system for distributing electronic

content. In Nii's method, Nii teaches "a tailoring parameters register" by which to determine

preferences ("tailorization parameters") based on a quantity of previous orders ("list of previous

items purchased"), each order corresponding to a genre (¶¶ 0024, 0027, 0072, 0075, and 0079).

In Nii the preferences are used for "tailorization of the content to be delivered on a terminal per

terminal basis," where "information to be delivered to that particular terminal is tailored in

accordance with the preferences, settings, etc."

Nii's system also performs *arranging* said plurality of content data in accordance with

said preference data managed in said managing (see at least fig. 1, depiction of content arranged

numerically for user to select).

Accordingly, every *structural element* (as best understood by the Examiner)

corresponding to the argued *functions* have been shown in the prior art. For this second reason,

the rejection under §103 should be sustained.

Official Notice Arguments

With respect to claims 2 and 8, Appellant argues:

> Moreover, Applicants note that the features disclosed in Claims 2 and 8 are not
> are not capable of instant and unquestionable demonstration as being well-known.
> As is noted in MPEP §2144.03, "it is never appropriate to rely solely on "common
> knowledge" in the art without evidentiary support in the record, as the principal
> evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d
> at 1697."

See 2009 Appeal Brief, P11, L22-26.

From the reply above, it appears that Appellants are challenging the official notice.

First, the Examiner finds that Appellant are for the *very first time* challenging the official notice in the 2009 Appeal Brief.

Second, the Examiner finds that the Officially Notices statements where present in the non- final office action mailed 18 March 2009 (Paper No. 20090305), page 11, ¶22 and ¶22(bb.).

Third the Examiner finds that Applicant did not mention, let alone *adequately traverse*, the officially noticed statements in their reply of 19 May 2009.

Forth, because Applicant did not mention, let alone adequately traverse, the officially noticed statements in their reply of 19 May 2009, the Examiner concluded in the final rejection mailed 4 August 2009 (Paper No 20090723, page 18, ¶56 and ¶57), that Appellant failed to traverse the officially noticed statements. The Examiner also stated in Paper No 20090723, ¶56 and ¶57 that because Appellants did not traverse the official noticed statements, "the Official Notice statements from Paper No 20090305 ¶23 bb are taken to be admitted prior art. See MPEP 2144.03."

It is the Examiner's position that because Applicant did not traverse the officially noticed statements in his 19 May 2009 response, the Board does not have subject matter jurisdiction on this issue. The Board does not have subject matter jurisdiction on this issue because Appellant has either (1) waived this issue or (2) abandoned his application. See *In re Goodman*, 3 USPQ2d 1866, (ComrPats 1987).

The issue becomes: did Appellant's 19 May 2009 response comply with 37 C.F.R.

§1.111(b)? If Appellant elects to now, for the first time, challenge the officially noticed

statements in his appeal brief, the Examiner concludes that because Appellant's 19 May 2009

response did not even attempt to traverse the officially noticed statement, Appellant's 19 May

2009 response would be in violation of 37 C.F.R. §1.111(b).

First, the Examiner notes that patent examiners have no authority to waive 37 C.F.R.

§1.111(b). *Goodman*, 3 USPQ2d at 1871 noting the examiners have no authority to waive 37

C.F.R. §1.111(b).

Second, like *Goodman*, Appellant's 19 May 2009 "response was so insufficient, that, as a

matter of law, they were not entitled to reconsideration" *Goodman*, 3 USPQ2nd at 1871, of

whether or not the officially noticed statements are admitted prior art.

Third, the Examiner recognizes that patent applicants need not point out the supposed

errors on issues that the applicant waives or elects not to traverse. However, Goodman clearly

states that "the rule makes it plain that any response must clearly point out the purported errors in

the examiner's action. The penalty for failing to do so may be abandonment of the application."

Goodman, 3 USPQ2nd at 1868.

In conclusion, it is the Examiner's ***principle position*** that Appellant's have **waived** his

ability to traverse the officially noticed statements. Alternatively, if the Board desires to address

Appellant's official notice arguments on the merits, the Examiner respectfully requests the Board

to **remand** this application to the Examiner with instructions to abandon this application as of 18

June 2009 (3 months after the mailing date of the non-final office action) for failure to comply

with 37 C.F.R. §1.111(b).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This Examiner's answer contains a new ground of rejection set forth in section **(9)** above.

Accordingly, Appellant must within **TWO MONTHS** from the date of this answer exercise one

of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject

to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary

examiner by filing a reply under 37 C.F.R. § 1.111 with or without amendment, affidavit or other

evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of

rejection. A request that complies with 37 C.F.R. § 41.39(b)(1) will be entered and considered.

Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set

forth in 37 C.F.R. § 41.41. Such a reply brief must address each new ground of rejection as set

forth in 37 C.F.R. § 41.37(c)(1)(vii) and should be in compliance with the other requirements of

37 CFR 41.37(c). If a reply brief filed pursuant to 37 C.F.R. § 41.39(b)(2) is accompanied by

any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be

reopened before the primary examiner under 37 C.F.R. § 41.39(b)(1).

Extensions of time under 37 C.F.R. § 1.136(a) are not applicable to the TWO MONTH

time period set forth above. See 37 C.F.R. § 1.136(b) for extensions of time to reply for patent

applications and 37 C.F.R. § 1.550(c) for extensions of time to reply for ex parte reexamination

proceedings.

Respectfully submitted,

/JACOB C. COPPOLA/
Examiner, Art Unit 3621
May 25, 2010

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621

Conferees:

/A. J. F./
Andrew J. Fischer
Supervisory Patent Examiner, Art Unit 3621

A Technology Center Director or designee must personally approve the new

ground of rejection set forth in section (9) above by signing below: